

S. Little
9/23/02
PATENT

#13/B
N.E.

CERTIFICATE OF MAILING UNDER 37 CFR 1.8(a)

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, U.S. Patent and Trademark Office, Washington, D.C. 20231.

August 30, 2002
Date

Denise G. Gunvalsen
Name of person mailing paper

Denise G. Gunvalsen
Signature

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Applicant: Chamberlin, III et al.

Serial No: 09/727,622

Filing Date: December 1, 2000

Art Unit: 3747

Examiner: Hai H. Huynh

RECEIVED
SEP 17 2002
TECHNOLOGY CENTER 3700

Title: **METHOD OF OPERATING AN INTERNAL COMBUSTION ENGINE**

Commissioner for Patents
U.S. Patent and Trademark Office
Washington, D.C. 20231

RESPONSE TO OFFICE ACTION DATED MAY 13, 2002

Dear Sir:

This is a response to the non-final rejection mailed May 13, 2002 for the above-identified application. A Petition for a one-month Extension of Time is being filed concurrently with this response.

The Examiner has indicated that the applicant is reminded of the proper language and format for an abstract of the disclosure and indicates that the abstract should not exceed 150 words. The Examiner did not specifically indicate that the abstract of disclosure submitted with the present application was objectionable. However, in order to expedite prosecution of the application, applicants submit the enclosed alternative abstract of disclosure which should be sufficient to conform with all applicable patent office rules.

Claims 1, 3-9 and 13-41 have been rejected under 35 U.S.C. § 103(a) as unpatentable over Buehrle, II et al. (U.S. Patent 6,024,060) in view of Manka et al. (U.S. Patent 5,834,407). This rejection is respectfully traversed.

Buehrle, II et al. is cited in the applicants' specification as disclosing a camless internal combustion engine suitable for use with the applicants' claimed method (see, applicants' specification at page 17, line 26 to page 18, line 26). Buehrle, II et al. does not, however, provide any disclosure relating to the composition of any lubricating oil composition that might be used, and the reference certainly does not disclose or suggest a low-phosphorus or phosphorus-free lubricating oil composition as specified in the applicants' claims.

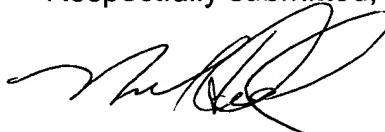
Manka et al. discloses a lubricating oil composition comprising a major amount of an oil of lubricating viscosity and a minor amount of certain heterocyclic compounds. The reference indicates that the lubricating oil composition may contain certain phosphorus-containing compounds (see, column 14, line 17 to column 22, line 14) and that the amount of phosphorus contributed to the lubricating composition by such phosphorus-containing compounds may be "up to about 0.12% by weight... and in one embodiment up to about 0.08% by weight..." (see, column 28, lines 49-60). This reference does not disclose or suggest that the lubricating oil composition disclosed therein can be used in a camless internal combustion engine as specified in the applicants' claims.

Buehrle, II et al. discloses a camless engine but provides no information concerning the lubricating oil used in the engine. Manka et al. discloses a lubricating oil composition containing reduced levels of phosphorus, but the reduced levels disclosed therein can be as high as 0.12% by weight which exceeds the amount specified in the applicants' claims by 50%. Neither reference discloses or suggests operating a camless internal combustion

engine using a phosphorus-free or low-phosphorus lubricating oil composition as specified in the applicants' claims. Neither reference provides the suggestion for combining the teachings of such references. It is respectfully submitted that the combination of references selected by the Examiner could only have been arrived at with the hindsight benefit of the applicants' disclosure. Accordingly, withdrawal of the rejection is believed to be warranted and is respectfully requested.

Applicants believe that the application is now in condition for allowance. A Notice of Allowance is respectfully requested.

Respectfully submitted,



Neil A. DuChez, Reg. No. 26,725

The Lubrizol Corporation
29400 Lakeland Boulevard
Wickliffe, Ohio 44092-2298
Telephone: (216) 621-1113
Facsimile: (216) 621-6165